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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,507	10/28/2003	Colin Savage	14137.0001	5430

27611   7590   06/29/2007

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EXAMINER
DOAN, TRANG T

ART UNIT	PAPER NUMBER
2131	

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06/29/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

	Application No.	Applicant(s)
	10/695,507	SAVAGE ET AL.
Office Action Summary	**Examiner**	**Art Unit**	
	Trang Doan	2131	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 April 2007*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 and 11-13* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1 and 11-13* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *28 August 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1.   This action is in response to the Election/Restriction filed on 04/11/2007.

2.   Newly submitted claim 10 is directed to an invention that is independent or

distinct from the invention originally claimed for the following reasons: claim 10 is a

combination claim of a method for providing session protection and a method for

providing private storage services. Since claim 1 claims only a session protection but

not private storage services. Therefore, the subject matter discloses in claim 10 is not

related to the subject matter discloses in claim 1.

Since applicant has received an Election/Restriction action on the merits for the

originally presented invention, this invention has been constructively elected by original

presentation for prosecution on the merits. Accordingly, claim 10 has withdrawn from

consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and

MPEP § 821.03.

3.   Claims 1 and 11-13 are pending for consideration.

Claim Objections

4.   Regarding claims 12-13, the Examiner interprets these claims that depend on

claim 1 not claim 10. Appropriate correction is required.

Claim Rejections - 35 USC § 112

5.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

6.   Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite

for failing to particularly point out and distinctly claim the subject matter which applicant

regards as the invention.

7.   Claim 1 recites the limitation "said application" in line 2 page 3. There is

insufficient antecedent basis for this limitation in the claim.

Double Patenting

8.   The nonstatutory double patenting rejection is based on a judicially created
doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the
unjustified or improper timewise extension of the "right to exclude" granted by a patent
and to prevent possible harassment by multiple assignees.   A nonstatutory
obviousness-type double patenting rejection is appropriate where the conflicting claims
are not identical, but at least one examined application claim is not patentably distinct
from the reference claim(s) because the examined application claim is either anticipated
by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140
F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29
USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.
1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422
F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163
USPQ 644 (CCPA 1969).
        A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d)
may be used to overcome an actual or provisional rejection based on a nonstatutory
double patenting ground provided the conflicting application or patent either is shown to
be commonly owned with this application, or claims an invention made as a result of
activities undertaken within the scope of a joint research agreement.
        Effective January 1, 1994, a registered attorney or agent of record may sign a
terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with
37 CFR 3.73(b).
9.   Claim 1 is rejected on the ground of nonstatutory obviousness-type double

patenting as being unpatentable over claim 1 of U.S. Patent No. 6442687. Although the

conflicting claims are not identical, they are not patentably distinct from each other

because claim 1 of the instant application and claim 1 of the patent application are

functionally equivalent.

10.   The following table shows the complete mapping of the claims between the

instant application and the patent application.

Instant Application 10/695507	Patent Application 6442687
1. A **method for providing session protection for user privacy over a network**, by means including at least a client and a remote server, wherein a user, using a client application, may submit a request through said client for a specified action to be performed in response to said request by said remote server, said user-submitted request comprising identity information that identifies the user making the request, and action information that specifies the action requested from said remote server by said user, wherein said communications are provided in a secure and anonymous manner in that said action information is submitted to said remote server without revealing said identity information to said remote server, and in that only said client, and not any facility through which said action information or any response thereto passes in the course of being submitted to or received from said remote server, possesses both said identity information and said action information, said system comprising (in addition to said client and remote server): (a) separating, within said client application, said identity information and said action information from the user's information request, encrypting said action information, and **sending said identity information and said action information as so encrypted to an identity server;** (b) **transmitting said encrypted action information from said identity server to an action server;** (c) decrypting, within said action server, said action information, transmitting said decrypted action	1. A **system for providing communications over a network**, by means including at least a client and a remote server, wherein a user may submit a request through said client for a specified action to be performed in response to said request by said remote server, said user-submitted request comprising identity information that identifies the user making the request, and action information that specifies the action requested from said remote server by said user, and wherein said communications are provided in a secure and anonymous manner in that said action information is submitted to said remote server without revealing said identity information to said remote server, and in that only said client, and not any facility through which said action information or any response thereto passes in the course of being submitted to or received from said remote server, possesses both said identity information and said action information, said system comprising (in addition to said client and remote server): a) an application that separates said identity information and said action information from the user's information request, **encrypts said identity information and said action information, and sends said identity information and said action information as so encrypted to a first intermediate server;** b) said first intermediate server, which contains means for decrypting said encrypted identity information but not said

information to said remote server, **receiving the remote server's response, encrypting said remote server response, and transmitting said encrypted remote server response to said identity server;** (d) receiving, within said identity server said encrypted remote server response from said action server, **associating said encrypted remote server response with said identity information** and sending said encrypted remote server response to said application; and (e) decrypting, within said client application, said **remote server response and forwarding said decrypted remote server response to said client for presentation to said user.**	encrypted action information, and for **transmitting said encrypted action information to a second intermediate server;** c) said second intermediate server, which contains means for decrypting said action information, transmitting said decrypted action information to said remote server, **receiving the remote server's response, encrypting said remote server response, and transmitting said encrypted remote server response to said first intermediate server;** d) said first intermediate server further having means for receiving said encrypted remote server response from said second intermediate server, **associating said encrypted remote server response with said identity information** and sending said encrypted remote server response to said application; e) said application further having means for **decrypting said remote server response and forwarding said decrypted remote server response to said client for presentation to the user.**

Claim Rejections - 35 USC § 103

11.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. · Patentability shall not be negatived by the manner in which the invention was made.

12.   Claims 1 and 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Smith et al. (US 6061448) (hereinafter Smith) in view of Luo (US 5909491)

(hereinafter Luo).

13.   Regarding claim 1, Smith discloses (a) separating, within said client application,

said identity information and said action information from the user's information request,

encrypting said action information, and sending said identity information and said action

information as so encrypted to an identity server (Smith: see figure 3 and column 4 line

64 through column 5 line 30 and column 6 lines 40-49); (b) transmitting said encrypted

action information from said identity server to an action server (Smith: see figure 3 and

column 4 line 64 through column 5 line 30 and column 6 lines 40-49); (c) decrypting,

within said action server, said action information, transmitting said decrypted action

information to said remote server, receiving the remote server's response, encrypting

said remote server response, and transmitting said encrypted remote server response

to said identity server (Smith: see figure 3 and column 4 line 64 through column 5 line

30 and column 6 lines 40-49); (d) receiving, within said identity server said encrypted

remote server response from said action server, associating said encrypted remote

server response with said identity information and sending said encrypted remote server

response to said application (Smith: see figure 3 and column 4 line 64 through column 5

line 30 and column 6 lines 40-49); and (e) decrypting, within said client application, said

remote server response and forwarding said decrypted remote server response to said

client for presentation to said user (Smith: see figure 3 and column 4 line 64 through

column 5 line 30 and column 6 lines 40-49).

Smith does not specifically disclose in detail moving an encrypted data from one server to the next server. However, Luo discloses moving encrypted data from one server to the next server (Lou: see figure 1 and Abstract section). Therefore, it would have been obvious to one ordinary skill in the art at the time of the invention was made to modify the procedure in Smith to include encrypted data moving from one server to the next server as taught by Luo, because such modification would provide secure communications to users of the system (Luo: column 1lines 30-31).

14.   Regarding claim 11, Smith in view of Luo discloses wherein said identity server and said action server are implemented as processes or threads which may execute on the same or different computers (Smith: see figure 3 and column 4 lines 36-49).

15.   Regarding claim 12, Smith in view of Luo discloses carried out in a distributed operating environment in which there are a plurality of users, a plurality of first intermediate identity servers and a plurality of second intermediate action servers, all communicating in accordance with the method of claim 1 (Smith in view of Luo discloses).

16.   Regarding claim 13, Smith in view of Luo discloses wherein said identity server and said action server are implemented as processes or threads which may execute on the same or different computers (Smith in view of Luo discloses).
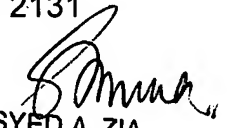
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Trang Doan whose telephone number is (571) 272-0740. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Trang Doan
Examiner
Art Unit 2131

T.D.

SYED A. ZIA
PRIMARY EXAMINER